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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/843,609	04/26/2001	Maurice Herlihy	0102788-00009	7659
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NUTTER MCCLENNEN & FISH LLP WORLD TRADE CENTER WEST 155 SEAPORT BOULEVARD BOSTON, MA 02210-2604			EXAMINER NGUYEN, HAI V	
			ART UNIT	PAPER NUMBER
			2142	

DATE MAILED: 10/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/843,609

Applicant(s)

HERLIHY, MAURICE

Examiner

Hai V. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 August 2005.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3,4 and 6-24 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1,3,4 and 6-24 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This Office Action is in response to the communication received on 04 August 2005.
2. Claims 2, 5, 25 are cancelled.
3. Claims 1, 3-4, and 6-24 are presented for examination.

### ***Specification***

4. The textual portion of the specification is replete with grammatical and idiomatic errors too numerous to mention specifically. The specification should be revised carefully.
5. The applicant should use this period for response to thoroughly and very closely proof read and review the whole of the application for correct correlation between reference numerals in the textual portion of the Specification and Drawings along with any minor spelling errors, general typographical errors, accuracy, assurance of proper use for Trademarks <sup>TM</sup>, and other legal symbols ®, where required, and clarity of meaning in the Specification, Drawings, and specifically the claims (i.e., provide proper antecedent basis for "the" and "said" within each claim). Minor typographical errors could render a Patent unenforceable and so the applicant is strongly encouraged to aid in this endeavor.

### ***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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7. Claims 1, 13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 1, 13 recite that, "...a process that makes requests and that requires at least synchronous response to those requests to continue a first mode of operation,". The first mode of operation is not enabled in the specification. What is the first mode of operation? and How is the first mode of operation runs?

***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1, 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. Regarding claims 1, 13, the phrase "such that" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 1, 3-4, 6-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Shavit** U.S. patent #: **6,304,972 B2** in view of **Sharma** U.S. patent #: **6,249,818**.

13. As to claim 1, Shavit discloses a digital data computing method comprising: utilizing a set of secured instructions and secured memory local to a client to execute, on the client (*Fig. 1, lessee site 26*), a process that makes requests and that requires at least asynchronous responses to those requests to continue a first mode of operation (*Shavit, Fig. 1, lessee site 26, col. 1, line 62 – col. 3, line 23*); generating, on a server, those responses external to the process and supplying them to that process (*Shavit, Fig. 1, lessor site 14, col. 1, line 62 – col. 3, line 23*); However, Shavit does not explicitly disclose continuing the first mode of operation of the process when at least asynchronous responses are received to the requests and otherwise discontinuing the first mode of operation; such that there is no real-time dependency of that process to those responses. Thus, the artisan would have been motivated to look into the related networking arts for potential methods and apparatus for implementing continuing the first mode of operation of the process when at least asynchronous responses are received to the requests and otherwise discontinuing the first mode of

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operation; such that there is no real-time dependency of that process to those responses.

In the same field of endeavor, Sharma, related Network Transport Driver Interfacing, discloses (e.g. normal operation of process) that *when the application makes the request and the request is delivered to transport service providers then the application discontinues the normal operation, e.g., instead of waiting for the response, the application now can do other things so there is no real time dependency of that application to the responses (Sharma, col. 3, lines 3-15).*

Accordingly, it would have been obvious to one of ordinary skill in the networking art at the time the invention was made to have incorporated Sharma's teachings of normal operation of the process of the application requests (*Sharma, col. 3, lines 3-15*) with the teachings of Shavit for the *purpose of the application program is free to engage in activities other than waiting for completion of the requested service (Sharma, col. 3, lines 3-15).*

14. As to claim 3, Shavit-Sharma discloses performing the executing step on a server that comprises a secured coprocessor local to the client (*Shavit, Fig. 3*).

15. As to claim 4, Shavit-Sharma discloses performing the executing step on a server that is remote with respect to the client (*Shavit, Fig. 3*).

16. As to claim 6, Shavit-Sharma discloses wherein it is computationally difficult to unauthorizedly simulate generation of the responses (*Shavit, col. 4, lines 23-54*).

17. As to claim 7, Shavit-Sharma discloses, wherein the executing step includes executing transformed code and wherein it is computationally difficult to determine

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proper responses to the requests without access to at least a portion of that code prior to a transformation that produces that transformed code (*Shavit, col. 5, line 29 – col. 9, line 8*).

18. As to claim 8, Shavit-Sharma discloses performing the transformation automatically (*Shavit, Fig. 3, col. 5, line 29 – col. 9, line 8*).

19. As to claim 9, Shavit-Sharma discloses performing the transformation manually (*Shavit, Fig. 3, col. 5, line 29 – col. 9, line 8*).

20. As to claim 10, Shavit-Sharma discloses, generating non-deterministic responses to the requests (*Shavit, Fig. 3, col. 5, line 29 – col. 9, line 8*).

21. As to claim 11, Shavit-Sharma discloses executing transformed code and wherein it is computationally difficult to generate the nondeterministic response without access to at least a portion of that code prior to a transformation that produces that transformed code (*Shavit, Fig. 3, col. 5, line 29 – col. 9, line 8*).

22. As to claim 12, Shavit-Sharma discloses securing the generation of responses against any of unauthorized use, access, copying and functional analysis, and of controlling the execution of the process (*Shavit, Fig. 3, col. 4, lines 23-53; col. 5, line 29 – col. 9, line 8*).

23. Claim 13 had similar limitations of claim 1; therefore, it is rejected under the same rationale as in claim 1.

24. As to claim 14, Shavit-Sharma discloses, wherein the code is comprised of high level language or object code or any intermediary level set of computer instructions, or microcode (*Shavit, Fig. 3, col. 1, line 61 – col. 3, line 23*).

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25. As to claim 15, Shavit-Sharma discloses performing a transformation that includes generating any of code and data upon which the responses are based (*Shavit, Fig. 3, col. 5, line 29 – col. 9, line 8*).

26. Claims 16-21 have similar limitations of claims 8-9, 6-7, 10-11; therefore, they are rejected under the same rationale as in claims 8-9, 6-7, 10-11.

27. As to claim 22, Shavit-Sharma discloses, comprising performing executing the code subsequent to transformation on the client (*Shavit, Fig. 3, col. 5, line 29 – col. 9, line 8*).

28. Claims 23-24 have similar limitations of claims 3-4; therefore, they are rejected under the same rationale as in claims 3-4.

29. Further references of interest are cited on Form PTO-892, which is an attachment to this action.

### ***Response to Arguments***

30. Applicant's arguments with respect to claims 1, 13 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

31. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within



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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai V. Nguyen whose telephone number is 571-272-3901. The examiner can normally be reached on 6:00-3:30 Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on 571-272-3868. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hai V. Nguyen  
Examiner  
Art Unit 2142



THONG VU  
Primary Examiner  
